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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/720,825      | 11/24/2003  | Craig L. Reding      | 03-1025             | 5353             |

32127 7590 09/27/2006

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EXAMINER

PHAN, HUY Q

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/720,825

Applicant(s)

REDING ET AL.

Examiner

Huy Q. Phan

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9, 10, 12, 13, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 10, 12, 13, 16, and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is in response to Amendment filed on date: 09/07/2006.

Claims 1-7, 9, 10, 12, 13, 16, and 17 are still pending.

Claims 8, 11, 14, and 15 are canceled.

### ***Response to Arguments***

2. Applicant's arguments, see REMARKS, have been fully considered but they are not persuasive.

a) Applicant argued that "Karve does not disclose or suggest formatting the SMS message according to characteristics of the preferred device" (see REMARKS pages 8-9). The examiner respectfully disagrees. Based on the claim language in view of the instant specification (see para. [0094]), the examiner interprets the limitation "formatting the SMS message according to characteristics of the preferred device" to read on "The SMS center looks at the header information, adds some additional header information, and then tries to send the user data to the recipient or destination address. The format of short messages, sending and receiving of short messages, and the operations of SMS centers are well known to those of skill in the art" (see [0028]). Karve also discloses that SMS messages can be sent to/from a number of the different communication devices such as a mobile phone, a fax machine, a PC or an Internet address (see [0008]). Since these different communication devices have different SMS messages formats, the SMS center must uniquely format the message to suit each

communication device's type before it sends to the specific communication device. Therefore, Karve discloses the claimed limitation of formatting the SMS message according to characteristics of the preferred device.

b) Applicant argued that "Karve does not disclose or suggest sending the formatted message to an e-mail address" (see REMARKS page 10). The examiner respectfully disagrees. Karve does disclose formatting the SMS message (see section above). Based on the claim language in view of the instant specification (see [0029] and [0059]), the examiner interprets the limitation "sending the formatted message to an e-mail address" to read on "messages can also be sent to/from a fax machine, a PC or an Internet address". Since Karve also discloses that SMS messages can be sent to a PC or an Internet address (see [0008]), therefore Karve discloses the claimed limitation of "sending the formatted message to an e-mail address".

c) Applicant argued that "Karve does not disclose or suggest storing messages in a database when the preferred device is not available" (see REMARKS page 7). Karve discloses that SMS is a store and forward service (see [0007]) and more specifically that "the message is stored in the memory 24. When the user desires to read the message, the user issues the appropriate commands as understood by those of ordinary skill in the art, until the message is displayed on the screen" (see [0030]) The examiner interprets that the teaching of message can be stored for the later use or

when the user is available. Therefore, Karve suggests the use of storing messages in a database when the preferred device is not available.

The examiner relies upon reference, as a whole, to anticipate the instant claims. Reference's specific citations are to pinpoint pertinent passages to aid in the understandings of the reference as applied to the particular claimed elements.

With all the reasons stated above, the rejection is deemed proper and still stands.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

a) Claims 1-3, 6, 7, 9, 10, 12, 13, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Karve (US-2002/0137530).

Regarding claim 1, Karve discloses a method for providing SMS messages (fig. 3 and its description) to a receiving party (owner of telephone 10, [0029]) associated, able to communicate, with a plurality of devices (interpreted as "forwarding a received short message from the telephone 10 to another device or telephone" see [0029]), the method comprising:

receiving a SMS message for a first device ("telephone 10") of the plurality of devices ([0028]-[0029]);

identifying a second device of the plurality of devices as a preferred device ("a predefined number" [0032]-[0035]) for receiving the SMS message based on information stored by the receiving party ([0032]-[0035]);

formatting the SMS message according to characteristics of the preferred device [0028]; and

sending the formatted message to the preferred device ([0008]-[0010] and [0032]-[0035]).

Regarding claim 2, Karve discloses the method of claim 1, wherein sending the formatted message comprises sending the formatted message to a SMS-capable device ([0008] and [0028]).

Regarding claim 3, Karve discloses the method of claim 1, wherein sending the formatted message comprises sending the formatted message to an e-mail address ([0008] and [0028]).

Regarding claim 6, Karve discloses the method of claim 1, wherein sending the formatted message comprises sending the formatted message to digital companion client software (described as "the appropriate programming at the SMS center or by allowing the user to define forwarding address lists stored at the SMS center" see

[0033]).

Regarding claim 7, Karve discloses the method of claim 1, comprising: storing messages in a database when the preferred device is not available to receive messages [0030].

Regarding claim 9, Karve discloses an apparatus (fig. 2 and description) for providing SMS messages to a user (owner of telephone 10, [0029]) associated, able to communicate, with a plurality of devices (interpreted as “forwarding a received short message from the telephone 10 to another device or telephone” see [0029]), comprising:

a database (“a memory at the SMS center” see [0033]) for storing information identifying each device of the plurality of devices (described as “identifying a pointer to a multiple destination address stored in a memory at the SMS center” see [0033]) and identifying a first device of the plurality of devices as a preferred device (described as “with the appropriate programming at the SMS center or by allowing the user to define forwarding address lists stored at the SMS center” see [0033]);

a gateway server (“SMS center” see [0028]) for receiving a SMS message identifying a second device (“telephone 10”, see [0029]) of the plurality of devices (interpreted as “forwarding a received short message from the telephone 10 to another device or telephone” see [0029]);

a server function for identifying the preferred device in response to receiving the SMS message [0033], the preferred device being different than the second device (two different devices); and

a SMS server for sending the SMS message to the preferred device ([0033]-[0035]), the SMS server being further configured to format the SMS message in accordance with characteristics of the preferred device before sending the message to the preferred device ([0008]-[0010] and [0028]-[0040])

Regarding claim 10, Karve discloses the apparatus of claim 9, wherein the SMS server is further configured to store messages to a database when the preferred device is not available to receive messages ([0028]-[0029] and [0007]).

Regarding claim 12, Karve discloses an apparatus for providing SMS messages to a user (owner of telephone 10, [0029]) associated, able to communicate, with a plurality of devices (interpreted as "forwarding a received short message from the telephone 10 to another device or telephone" see [0029]), comprising:

means for storing a specification of a preferred device ("a predefined number" [0032]-[0035]);

means for receiving a SMS message identifying one device ("telephone 10", see [0029]) of the plurality of devices [0028];



means for selecting the preferred device in response to receiving the SMS message ([0027]-[0035]), the preferred device being different than the identified one device (two different devices); and

means for sending the SMS message to the preferred device ([0032]-[0035]), the means for sending the SMS message comprises means for formatting the SMS message in accordance with characteristics of the preferred device before sending the message to the preferred device ([0008]-[0010] and [0028]-[0040]).

Regarding claim 13, Karve discloses the apparatus of claim 12, wherein the means for sending the SMS message comprises means for storing messages to a database when the preferred device is not available to receive messages ([0028]-[0029] and [0007]).

Regarding claim 16, Karve discloses a method (fig. 3 and its description), comprising:

receiving a SMS message [0028] including information identifying a first destination device ("telephone 10", see [0029]);

identifying a second destination device ("a predefined number" [0032]-[0035]) in response to receiving the SMS message, the second destination device being different than the first destination device (two different devices);

formatting the SMS message based on the second destination device [0028];  
and

sending the formatted SMS message to the second destination device ([0032]-[0035]).

Regarding claim 17, Karve discloses the method of claim 16 wherein the first destination device and the second destination device (interpreted as "forwarding a received short message from the telephone 10 to another device or telephone" see [0029]) are associated, able to communicate, with a receiving party (owner of telephone 10, [0029]), and wherein the identifying includes: identifying the second destination device based on a profile associated with receiving party ([0032]-[0033]).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a) Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karve in view of Dehlin (US-2004/0203942).

Regarding claim 4, Karve discloses the method of claim 1 except wherein sending the formatted message comprises sending the formatted message to an instant messenger client. However in analogous art, Dehlin teaches wherein sending the formatted message comprises sending the formatted message to an instant messenger client (described as "The reply customized SMS message is translated into a reply

instant message” or “SMS message has been identified as an instant message type” see abstract and [0031]). Since, Karve and Dehlin are related to the SMS of communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Karve as taught by Dehlin for purpose of “enabling instant messaging on a mobile device” (see Dehlin’s title and specification).

b) Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karve in view of Sabo (US-2003/0096626).

Regarding claim 5, Karve discloses the method of claim 1 except wherein sending the formatted message comprises sending the formatted message as a voice message to a phone. However in analogous art, Sabo teaches wherein sending the formatted message comprises sending the formatted message as a voice message to a phone (described as “SMSC 18 translates the secure SMS message to a voice message, using a text-to-speech translator 24 comprised in the SMSC, and transmits text message 38 as a voice message 40” see [0031]. Since, Karve and Sabo are related to the SMS of communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Karve as taught by Sabo for purpose of “in the case of the landline telephone, the translation is preferably to speech in a text-to-speech converter associated with the SMSC” (see Sabo’s specification, para. [0013]).

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Fostick discloses that "Existing SMS services provide a means for forwarding messages to users, assuming that the message recipient is available to receive the message. No means is provided for the message sender to ascertain whether the recipient is actually available. A message sent to a non-available device, according to these existing SMS services, may be stored by the SMS Center until the receiver is available, at which time the message may be sent. This guarantees delivery" (see specification para. [0007]).

b) Knotts discloses "When the intended subscriber is not available because, for example, it is turned off or is outside of the service area of the SMS network, the attempt to deliver the short message at that time will fail. In this case, the short message will be retained in the SMSC assigned to that intended subscriber for a later delivery attempt. Thereafter, when the subscriber finally becomes available, e.g., is turned on or has moved into the service area of the SMS network, the relevant portions of the network (e.g., the mobile servicing center (MSC) and the home location register (HLR)) notify the SMSC to initiate delivery of the stored (i.e., previously failed) short messages" (see specification para. [0011]).

6. **THIS ACTION IS MADE FINAL.**

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

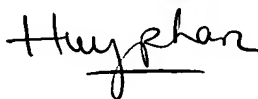
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Examiner: Phan, Huy Q.

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER

AU: 2617

Date: 09/19/2006